

REMARKS

This Amendment is responsive to the Office Action identified above, and is further responsive in any other manner indicated below.

CORRECTED DRAWING

Item 1 on page 2 of the Office Action indicated that reference numeral "501" was not present in the figures. Attached is a formal replacement sheet of drawings for FIGs. 5-7, with FIG. 5 corrected to include reference numeral 501 for identifying the objective pattern discussed in Paragraph [0053] on page 10 of the substitute specification.

Approval and entry of the formal replacement drawing for FIG. 5 is respectfully requested.

DRAWING OBJECTIONS/SPECIFICATION ADJUSTED

With regard to Items 2 and 3 spanning pages 2 and 3 of the Office Action, appropriate locations of Applicant's specification have been amended to correct the erroneous reference numerals, and to include previously-unmentioned reference numerals or labels found in the drawings. As the above is believed to obviate all the listed concerns, reconsideration and withdrawal of the objections to the drawings are respectfully requested. Any spelling, idiomatic, grammatical and/or other informality noted during further review of the disclosure/specification/drawings will be formally corrected upon such note.

PENDING CLAIMS

Claims 1-9 were pending, under consideration and subjected to examination in the Office Action. Appropriate claims have been amended, canceled and/or added (without prejudice or disclaimer) in order to adjust a clarity and/or focus of Applicant's claimed invention. That is, such changes are unrelated to any prior art or scope adjustment and are simply refocused claims in which Applicant is present interested. At entry of this paper, Claims 1-5 and 7-9 will be pending for further consideration and examination in the application.

ALLOWED CLAIMS

Claims 4 and 7-8 have been allowed in the application, as indicated within the sections numbered "8-9" on pages 6-7 of the Office Action. Ones of such claims have been minorly amended (e.g., to improve clarity, correct antecedents and/or remove extraneous portions) within this paper in a manner believed not to affect an allowability thereof. Reconsideration and renewal of the allowance are respectfully requested. Applicant and the undersigned respectfully thank the Examiner for such indication of allowable subject matter.

TAGUCHI *ET AL.* REJECTION UNDER 35 USC §102

The 35 USC §102 rejection of Claims 1-3 as being anticipated by Taguchi *et al.* (US 5,774,602 A) is respectfully traversed. Such rejections have been rendered obsolete by the present clarifying amendments to Applicant's claims, and accordingly, traversal arguments are not appropriate at this time. However,

Applicant respectfully submits the following to preclude renewal of any such rejections against Applicant's clarified claims.

All descriptions of Applicant's disclosed and claimed invention, and all descriptions and rebuttal arguments regarding the applied prior art, as previously submitted by Applicant in any form, are repeated and incorporated herein by reference. Further, all Office Action statements regarding the prior art rejections are respectfully traversed. As additional arguments, Applicant respectfully submits the following.

In order to properly support a §102 anticipatory-type rejection, any applied art reference must disclose each and every limitation of any rejected claim. The applied art does not adequately support a §102 anticipatory-type rejection because, at minimum, such applied art does not disclose (or suggest) the following discussed limitations of Applicant's claims.

Applicant's disclosed and claimed Claim 1-3 invention is directed toward obtaining picked-up images where an object of interest (*e.g.*, a line of text) is not at all obstructed by the image of the penpoint. That is, there is less processing involved if the image of a penpoint does not have to be recognized, extracted, etc. In order to accomplish such objective, Applicant's disclosed and claimed invention mounts the camera "so that a center position of the image picked up by said camera is located at left side (or right side) of the tip end of said pen."

Regarding the Office Action comments concerning Taguchi *et al.* in support of the rejection, the line spanning pages 3-4 of the Office Action states, "[s]ince the camera as disclosed by Taguchi *et al.* is removable one could position the camera

on the pen, whether it be on the right side or the left side of the pen depends on the like of the user.” Also, the end of the first full paragraph on page 4 of the Office Action states, “[i]t is inherent that if the camera is removeable, then the camera **may pivot relative to the penholder** within a range of at least 0 to 90.” Strong traversal is appropriate.

In order to properly support a §102 anticipatory-type rejection, the applied reference must explicitly disclose all features/limitations. The Office Action comments pertain to alleged modifications (*i.e.*, discretionary changes) to be made to Taguchi *et al.*, and accordingly, such are not explicitly disclosed within Taguchi *et al.* and thus the reference does not support the rejection.

Even regarding a §103 obviousness-type rejection, Taguchi *et al.* would not support such a rejection. More particularly, courts have held that an Examiner cannot make substitutions at will to references in a hindsight attempt to arrive at Applicant's invention. The Federal Circuit has stated, “[t]he mere fact that the prior art may be modified in a manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” *In re Fritch*, 972 F.2d 1260, 1266 n.14 (Fed. Cir. 1992), citing *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

Even beyond the above traversals, Applicant's clarified claims now explicitly recite “wherein said camera is mounted on said pen so that a central axis of said pen and an optical axis of said camera are non-co-planar, so that a center position of the image picked up by said camera is located at left side of the tip end of said pen.” Taguchi *et al.*'s arrangement has minimal explicit written disclosure regarding, for

example, its FIG. 18 embodiment, and it appears that Taguchi *et al.*'s central pen axis and camera optical axis are co-planar (*i.e.*, are contained within a common plane). According, Taguchi *et al.*'s teachings do not meet Applicant's disclosed and claimed invention.

In addition to the foregoing, the following additional remarks from Applicant's foreign representative are also submitted in support of traversal of the rejection and patentability of Applicant's claims.

The present invention is for inputting a pattern or a character string already written. In contrast to this, the invention by Taguchi *et al.* is for inputting a handwriting that a pen is presently describing. This means that Taguchi *et al.* gives none of such consideration for vertical writing or horizontal writing, with which the present invention deals. The feature in Taguchi *et al.* such that a camera can be mounted anywhere on a pen does not necessarily bring an idea such that "a camera can be mounted any place where suitable according to the purpose of use."

As a result of all of the foregoing, it is respectfully submitted that the applied art would not support a §102 anticipatory-type rejection of Applicant's claims. Accordingly, reconsideration and withdrawal of such §102 rejection, and express written allowance of all of the §102 rejected claims, are respectfully requested.

TOSHIFUMI *ET AL.* REJECTION UNDER 35 USC §102

The 35 USC §102 rejection of claims 5, 6 and 9 as being anticipated by Toshifumi *et al.* ("PaperLink: A Technique for Hyperlinking From Real Paper To Electronic Content") is respectfully traversed. Such rejections have been rendered

obsolete by the present clarifying amendments to Applicant's claims, and accordingly, traversal arguments are not appropriate at this time. However, Applicant respectfully submits the following to preclude renewal of any such rejections against Applicant's clarified claims.

All descriptions of Applicant's disclosed and claimed invention, and all descriptions and rebuttal arguments regarding the applied prior art, as previously submitted by Applicant in any form, are repeated and incorporated herein by reference. Further, all Office Action statements regarding the prior art rejections are respectfully traversed. As additional arguments, Applicant respectfully submits the following.

Unrelated to any prior art rejection, claim 6 has now been canceled without prejudice or disclaimer, thus rendering this rejection of such claims obsolete at this time. Patentability of remaining ones of the rejected claims are supported as follows.

In order to properly support a §102 anticipatory-type rejection, any applied art reference must disclose each and every limitation of any rejected claim. The applied art does not adequately support a §102 anticipatory-type rejection because, at minimum, such applied art does not disclose (or suggest) the following discussed limitations of Applicant's claims.

Claim 5 recites a pen type input device "wherein said information processing apparatus extracts an object to be processed from an image picked up by said camera, determines a process to be executed on a basis of a color of the penpoint detected from the picked-up image, and performs process of said extracted object."

Toshifumi *et al.* nowhere teaches determination of a process to be executed on a basis of a color of the penpoint detected.

Claim 9 recites a pen type input device “wherein said information processing apparatus uses an image of a standard pattern as picked-up by user pointing, to extract positioning correction values to be used to correct image pick-up during use for subsequent image pickup.” Toshifumi *et al.* nowhere teaches any correction values, let alone the specific correction value arrangement disclosed and claimed by Applicant.

In addition to the foregoing, the following additional remarks from Applicant’s foreign representative are also submitted in support of traversal of the rejection and patentability of Applicant’s claims.

Clarified claim 5’s modification is supported by the description from line 11 and after on page 28 in the specification, *i.e.*, the explanation for Fig. 31. That the process is switched according to the type of a penpoint is supported by the description from line 18 of page 15 to line 16 of page 23 of the specification. As the present specification describes, this “pen number” or color of the penpoint may be picked up by the camera.

Clarified claim 9 (Figs. 23 and 24) can be explained as follows. To register the user-favorite manner of pointing (such as: how far the user usually positions the penpoint below the object or how much tilt the user tends to hold the video pen), a preliminary initialization may be conducted of pointing to a standard pattern with the video pen before actual use, and to use this registered manner as the reference for

the pointing correction in the actual extraction operation of patterns (such as: command signs or character strings).

As a result of all of the foregoing, it is respectfully submitted that the applied art would not support a §102 anticipatory-type rejection of Applicant's claims. Accordingly, reconsideration and withdrawal of such '102 rejection, and express written allowance of all of the §102 rejected claims, are respectfully requested.

RESERVATION OF RIGHTS

It is respectfully submitted that any and all claim amendments and/or cancellations submitted within this paper and throughout prosecution of the present application are without prejudice or disclaimer of any scope or subject matter. Further, Applicant respectfully reserves all rights to file subsequent related application(s) (including reissue applications) directed to any/all previously claimed limitations/features which have been subsequently amended or cancelled, or to any/all limitations/features not yet claimed, *i.e.*, Applicant continues (indefinitely) to maintain no intention or desire to dedicate or surrender any limitations/features of subject matter of the present application to the public.

EXAMINER INVITED TO TELEPHONE

The Examiner is invited to telephone the undersigned at the local D.C. area telephone 703-312-6600, to discuss an Examiner's Amendment or other suggested action for accelerating prosecution and moving the present application to allowance.

CONCLUSION

In view of the foregoing amendments and remarks, Applicant respectfully submits that the claims listed above as presently being under consideration in the application are in condition for allowance. Accordingly, early allowance of such claims is respectfully requested.

A Petition for an appropriate extension of the shortened statutory period for response set by the 21 May 2004 Office Action is attached, along with a Form PTO-2038 authorizing payment of the requisite Petition Fee. To whatever other extent is actually necessary, Applicant respectfully petitions the Commissioner for an extension of time under 37 CFR §1.136. Please charge any actual required fee to ATS&K Deposit Account No. 01-2135 (as Case No. 503.39690X00).

Respectfully submitted,



Paul J. Skwierawski
Registration No. 32,173
ANTONELLI, TERRY, STOUT & KRAUS, LLP
1300 North Seventeenth Street, Suite 1800
Arlington, Virginia 22209-3801, USA
Telephone 703-312-6600
Facsimile 703-312-6666

Attachments:

One (1) Sheet of Formal
Replacement FIGs. 5-7
Petition for Extension of Time
Form PTO-2038 (Fee Code 1252)